

REMARKS

This is a full and timely response to the Office Action of November 30, 2004. By the present Amendment, the claims have been amended to more particularly and distinctly point out the novelty and non-obviousness of the present invention. Reconsideration and allowance of the application and all presently pending claims are respectfully requested.

As previously stated, the present invention provides a system and method for enabling the facilitation and fulfillment of wireless e-commerce transactions in a secure and convenient manner. The present invention further assists in tying e-commerce transactions to "real world" products and services, and provides appropriate systems to enable users to bypass traditional physical world limitations associated with traditional transactions or only partially integrated e-commerce transactions. For instance, in the movie ticket example described in the specification of the present application, a user is able to bypass a ticket point-of-sale location and proceed directly into the theater using the present invention.

In one aspect, the present invention can determine whether a requested transaction can be fulfilled (e.g., whether a requested rental car is available, whether a requested movie ticket is available). In doing so, the present invention simplifies the processing of fulfillable transaction requests, because if a requested transaction cannot be fulfilled, the requesting party can move on to a different request. Further, if the requested transaction can be fulfilled, the requester proceeds with the knowledge that the scanning of the code sent to and displayed by the wireless

device will fulfill the requested transaction. No further determinations will be required, and no further procedures will be required before the wireless device user will receive the requested item. Thus, the invention provides a system and method which truly facilitates and fulfills transactions for real-world products and/or services.

By the present Amendment, claims 1, 34 and 52 have been amended to more particularly claim the facilitation and fulfillment of wireless transactions for real-world products and services. Claim 1 has been amended to recite that the method therein pertains to a transaction requested for a commercial item that is not a coupon, and wherein a determination is made as to whether the transaction request can be fulfilled. Upon determining that said requested transaction can be fulfilled, the invention communicates the transaction code to the wireless device. Support for this amendment can be found, for example, on pages 17 and 23 of the specification of the present application, and no new matter is believed to have been added. Claims 34 and 52 have been amended similarly to amended Claim 1, and it is Applicant's position that nothing in the prior art of record teaches or suggests the invention as presently claimed.

Response to 35 USC 102 and 103 rejections

In the Office Action dated November 30, 2004, the Examiner has rejected claims 1-5, 13, 34 and 44-47 under 35 USC 102(e) based on U.S. Patent Application Publication No. 2002/0004746 A1 to Ferber et al. (hereinafter "Ferber"). The Examiner has further rejected claims 6-10, 14, 16-18, 20-21 and 35-37 under 35 USC 103(a) as being unpatentable over Ferber in view of U.S. Patent No. 5,590,038 to Pitroda ("Pitroda"). The Examiner has further rejected

claims 15, 19, 22-33 and 52 under 35 USC 103(a) as being unpatentable over Ferber. Based on the above amendments and the present remarks, Applicant submits that these rejections have been traversed and that the present claims are allowable over all prior art of record, considered singly or in combination.

In considering the present amendment and remarks, Applicant notes that the Ferber reference may only be used to support a rejection under 35 USC 102(e) or 35 USC 103(a) to the extent supporting subject matter is present in the provisional application relied upon by Ferber for priority (i.e., U.S. 60/198,092 filed April 17, 2000 (the '092 application)), as this is the only application with a priority date which predates Applicant's priority filing date of July 13, 2000. Applicant respectfully submits that any elements cited by the examiner from the Ferber publication which were not in the '092 application cannot be considered against Applicant's claims.

The Ferber reference cited by the Examiner describes an e-coupon channel for use with providing electronic coupon incentives based on user profiles (see abstract; paragraph [0002]). The aim of the Ferber reference is to provide and send appropriately targeted coupons to users to increase response rate, reduce fraud, and reduce administrative processing costs (see paragraph [0005]). No request is received for a non-coupon commercial item in Ferber. Further, no determination is made as to whether a requested transaction for a non-coupon commercial item can be fulfilled.

In contrast to the Ferber reference, the present invention as presently claimed provides for, among other things, receiving a transaction request from a transaction requester for a commercial item not in the form of a coupon, determining whether the requested transaction can be fulfilled and, upon determining so, communicating a first transaction code to a wireless communication device. In this way, for example, a transaction for a known-available item such as a rental car or a movie ticket can proceed. The user in the present invention who receives a transaction code on his or her wireless device proceeds with the secure feeling that the requested transaction *will be fulfilled* upon the scanning of the code. On the other hand, the user of the alleged invention in Ferber who receives a code has only received a coupon which may provide a discount on a commercial item *if* the item is available and *if* the coupon is still valid at the time of presentment.

It is thus Applicant's position that the Ferber reference teaches away from the facilitation of a transaction as in the present invention, as no request is received for a non-coupon commercial item, and no determination is made as to whether a requested transaction for a non-coupon commercial item can be fulfilled. For these reasons, Applicant submits that there is no teaching or suggestion of the invention as presently claimed in amended claims 1, 34 and 52.

Regarding the rejection of claims 14 and 16-18, on page 6 of the Office Action the Examiner has cited Figs. 1 and 4 of Ferber, as well as paragraphs [0008]-[0010], [0021], [0023] and [0028]-[0030]. However, it is not seen where these citations disclose or suggest the elements claimed in claims 14 and 16-18. Specifically, it is not seen where anything in Ferber

discloses communicating a second transaction code to the wireless communication device after receiving the first fulfillment verification (claim 14), optically scanning the second transaction code (claim 16), receiving a decoded representation of the second transaction code (claim 17), or receiving a second fulfillment verification after optically scanning the second transaction code (claim 18).

Further, as to claims 15, 19, 22-33 and 52, the Examiner has stated that these claims would have been obvious to one having ordinary skill in the art at the time of Applicant's claimed invention. However, the Examiner has cited no references in addition to the Ferber reference and has cited *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (7th Cir. 1977), for the proposition that mere duplication of the working parts of a device or duplication of steps involves only routine skill in the art. The facts of the *St. Regis* case indicate that the applicant was attempting to patent a combination of two old elements, and the court properly held that such a combination is not patentable unless the combination is synergistic, i.e., resulting in an effect greater than the sum of the several effects taken separately. *Id.* at 11. It is Applicant's position that this case is not properly applied to Applicant's invention as claimed, as Applicant is not combining two old elements, and the additional steps of communicating a second fulfillment verification to the transaction management system or communicating a second transaction code to the wireless communication device, as claimed in these claims, would not have been obvious and does not represent a "mere duplication of the essential working parts of a device or duplication of steps". Indeed, such additional steps provide a synergistic effect in the facilitation of multiple-stage e-commerce transactions. For instance, in the rental car example, if the

wireless device user does not scan a first transaction code indicating his or her arrival at an airport, it may not be necessary to maintain his or her reservation and it may not be necessary to issue a second transaction code for the user to use in indicating arrival at the car rental lot. Because these types of verifications and codes do not represent a combination of old elements, duplication of steps or duplication of working parts, Applicant submits that such steps as claimed would not be obvious to one having ordinary skill in the art at the time of the invention, considered in light of any of the prior art of record.

Even further, it is not seen how the Examiner has addressed the steps claimed in claims 29-31, specifically, communicating a transaction *message* to the wireless communication device after verifying the second transaction code (claim 29, emphasis added), communicating the transaction message from the transaction management system (claim 30) or communicating the transaction message from a transaction fulfillment system (claim 31). As described in the specification on page 17, for example, a transaction fulfillment message may be sent to the wireless device after verifying the transaction code for the purpose of providing hotel directions, city information, etc.

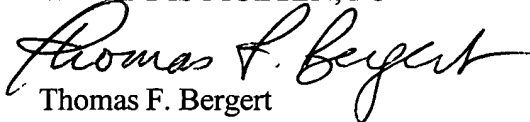
Applicant submits that claims 14-19, 22-33 and 52 are thus allowable, and separately submits that the dependent claims therein, as well as the remaining dependent claims, are allowable based upon being dependent from an allowable independent claim.

For the above reasons, Applicant submits that none of the cited references, taken either singly or combined, teaches or suggests the system and method of the present invention as presently claimed, and that the rejections in the Office Action of November 30, 2004 have been traversed.

CONCLUSION

Based on the foregoing, Applicant submits that the present application is in position for prompt adjudication and allowance. Applicant believes that all of the claims currently pending in the present application are now in condition for allowance, and an early notice to that effect is earnestly solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the present application, the Examiner is invited to contact Applicant's undersigned representative at the address and phone number provided below. A two-month extension of time is being filed simultaneously with this Amendment. The Commissioner is hereby authorized to charge Deposit Account No. 50-0766 in payment of the required fees.

Respectfully submitted,
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Filed: May 2, 2005
Attached: Petition for 2-month extension of time

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